

REMARKS

Claims 67, 118, 121, 122, 124, 125 and 126 were previously pending in this application. Claims 121, 122, 125 and 126 are withdrawn. Claim 67 has been amended to recite that the lower limit on the length of the nucleic acid is 24 nucleotides. Support for the amendment can be found at least on page 20, lines 4-5 of the specification as filed. Claim 124 has been amended to remove part (b) pertaining to hybridization language. No new matter has been added.

Rejection Under 35 U.S.C. § 112

The Examiner rejected claims 67, 118 and 124 under 35 U.S.C. §112, second paragraph, as being indefinite. Applicant respectfully requests reconsideration.

- A. Regarding the Examiner's statement that it is not clear whether the 12 nucleotides (now amended to recite 24 nucleotides) are continuous or discontinuous from the region of SEQ ID NO:681, Applicant respectfully asserts that the claim recites fragments of SEQ ID NO:681, which are continuous, not discontinuous, segments of SEQ ID NO:681 that include consecutive nucleotides.
- B. Applicant has amended claim 67 to clarify that the claimed nucleic acid molecules are selected from those recited in (a) and (b).
- C. Claim 118 has been amended to clarify the multiple recitations of the word "which" that the Examiner found confusing. Applicants believe that the amended claim is clear.
- D. Applicant has amended claim 124 to remove part (b). Thus the rejection made in view of term "stringent" is moot.
- E. Applicant wishes to note that, since the claimed sequence is selected from a group of sequences, it is not unclear to have plural and singular uses of the term "sequence" in a single

claim. However, to facilitate prosecution, claim 124 has been amended to change the use of the plural “sequences” to the singular “sequence”, and it is believed that the rejection on that basis is now moot.

F. Applicant has amended claim 124 to remove part (b). Thus the rejection made in view of term “cancer associated antigen” is moot.

In view of the foregoing, Applicant respectfully requests withdrawal of the rejection of the claims made under 35 U.S.C. § 112, second paragraph.

Rejection Under 35 U.S.C. § 102

A. The Examiner has rejected claims 67, 118 and 124 under 35 U.S.C. § 102(b) as anticipated by the GIBCO BRL Products and Reference Guide. Applicant respectfully requests reconsideration.

The Examiner indicated that for the purposes of examination, the claims have been “interpreted as encompassing virtually any complementary sequence of SEQ ID NO: 681, as well as virtually any sequence of same.” Office Action, page 4, paragraph 13. The Examiner further noted a run of at least 12 adenines at the 3’ end of SEQ ID NO:681.

The recitation in the GIBCO reference of an oligo (dT) primer of 4-22 nucleotides in length is asserted to anticipate the claimed invention.

Applicant has amended claim 67, to increase the lower limit to 24 nucleotides. The GIBCO/BRL reference does not provide a polynucleotide that matches those now claimed.

B. The Examiner has rejected claim 124 under 35 U.S.C. § 102(b) as anticipated by Brennan (US patent 5,474,796). Applicant respectfully requests reconsideration.

The Examiner interprets claim 124 as encompassing “virtually any nucleic acid sequence”. Office Action, page 5, paragraph 17. The reasoning provided for this interpretation is that (1) there is no lower limit on the length of the nucleic acid, and (2) the claim does not recite the specific stringent hybridization conditions.

According to the Examiner, the Brennan patent “discloses an array of isolated oligonucleotides that comprise all possible 10-mers”, and that this disclosure “fairly encompasses all 10-mers, nucleotide sequences fairly encompassed by at least one part of claim 124.” Office Action at page 5, paragraph 18. The Examiner concludes that this disclosure by Brennan anticipates the claimed invention.

Applicant has amended claim 124 so that it covers SEQ ID NO:681, sequences that differ from SEQ ID NO:681 due to the degeneracy of the genetic code, and full-length complements of these sequences.

There is nothing in Brennan that even remotely corresponds to the invention claimed in claim 124 as amended.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections made under 35 U.S.C. § 102.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

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